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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/650,101	08/26/2003	Bradley L. Todd	2001-IP-005443U2	6428

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EXAMINER

ZIMMER, MARC S

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 03/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/650,101

Applicant(s)

TODD ET AL.

Examiner

Marc S. Zimmer

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4,7-11,14-18,21,22,27 and 30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4,7-11,14-18,21,22,27 and 30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 12/09/05.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

Priority

It is Applicant's contention that the presently claimed invention is, in fact, properly enabled according to the requirements of 35 U.S.C. § 112, first paragraph in view of their disclosure at page 24, lines 13-21 (which, incidentally recites the same subject matter as does the passage on page 17 alluded to by the Examiner in the last correspondence). The Examiner respectfully disagrees.

It can only be presumed that Applicant is referring to their statement that "slowly soluble acid-generating compounds" may be employed because "encapsulated acids" are certainly not equivalent to the acid-releasing degradable material contemplated by Applicant's claims. Even were the Examiner to concede that this recitation of a "slowly soluble acid-generating compounds" represents an enabling disclosure for the acid-releasing degradable material now claimed, there is simply no support whatsoever for the specific types of acid-generating materials set forth in each independent method- and/or composition claim. The Examiner, therefore, maintains his position that Applicant is not entitled to the benefit of the earlier filing dated associated with 10/254,268.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-2, 7-9, 14-16, 21-22, 27, and 30 are rejected under 35 U.S.C. 102(e) as being anticipated by Nguyen, U.S. Patent Application Publication no. 2005/0028976 for the reasons cited in the correspondence dated September 6, 2005.

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3-4, 10-11, and 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nguyen, U.S. Patent Application Publication no. 2005/0028976 in view of Harris et al., U.S. patent # 5,813,466, Smith et al., U.S. Patent # 5,224,546, and/or Dawson et al., U.S. Patent # 6,793,018.

Nyugen only mentions the treating fluids, e.g. fracturing fluids and transport fluids for gravel packs, in general terms, there being no mention of the components that make up the fracturing/transport fluids themselves. Indeed, the focus of their disclosure is

largely on the coated particles that are incorporated into the fluids. In the absence of any indication as to what is conventional, or even suitable, for preparing these treating fluids, one of ordinary skill would turn to the related well treatment art to ascertain what materials are typically used in this capacity.

The Examiner has already cited during this prosecution several references that, likewise, are directed to well treating fluids. In all three cases, they advocate using viscous fluids comprising a crosslinked polymer. Further, in all instances, they recommend the employment of a polysaccharide such as guar gum or a cellulose derivative as the crosslinkable polymer (column 5, lines 16-33 of '018, column 3, lines 35 to 44 of '546, and column 3, lines 10-20 of '446.) Each of these documents likewise, contemplate using crosslinking agents like those recited in claims 3, 10, and 17 (see column 3, lines 40-57 of '018, column 4, lines 4-8 of '546, and column 3, lines 66-67 through column 4, lines 1-46 of '466).

Insofar as the invention suggested by the combination utilizes the same crosslinkable polymers and crosslinkers as are mentioned in Applicant's Specification, it is clear that the limitation of claims 4, 11, and 18 is inherently satisfied.

Sullivan et al., U.S. patent Application Publication no. 2005/0252659 is cited as being of interest for their disclosure of an invention conceptually similar to that being claimed. However, the effective filing date of this reference does not antedate that of instant application.


This Office action has not been made final only because the Examiner had not previously rejected claims 3-4, 10-11, and 17-18 over Nguyen.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc S. Zimmer whose telephone number is 571-272-1096. The examiner can normally be reached on Monday-Friday 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

February 28, 2006


MARC S. ZIMMER
PRIMARY EXAMINER